REMARKS

The Drawings

In a previous Office Action dated March 14, 2006, the Examiner objected to the drawings. In response, the Applicant submitted a set of replacement drawings with the amendment filed on May 17, 2006. In next Office Action dated June 24, 2006, the Examiner did not acknowledge receipt of the replacement drawings or indicate whether the replacement drawings have been accepted. In the Response filed on September 26, 2006 and in the Preliminary Amendment filed on October 26, 2007, Applicant respectfully requested that the Examiner indicate receipt and acceptance of the replacement drawings with the next correspondence to the Applicant. In the present Office Action, the Examiner is still silent on this issue. For the third time, Applicant respectfully requests that the Examiner indicate receipt and acceptance of the replacement drawings with the next correspondence to the Applicant.

The Non-statutory Obviousness-type Double Patenting Rejection

The Examiner rejected claim 1, 22 and 42 on non-statutory obviousness-type double patenting over claims 1, 12 and 15 of U.S. Patent No. 6,714,793. Applicant respectfully notes that a terminal disclaimer was filed with the Response filed on September 26, 2006 and with the Preliminary Amendment filed on October 26, 2006. In light of the already filed terminal disclaimer, Applicant notes that the non-statutory obviousness-type double patenting is not proper, and respectfully requests that it be withdrawn. For the Examiner's convenience, a copy of the terminal disclaimer is enclosed herewith.

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The 35 U.S.C. § 101 Rejection

The Examiner rejected claims 1-61 under 35 U.S.C. § 101 as lacking patentable utility. Applicant respectfully traverses this rejection. The Examiner states "the claim[s] fail to produce according to all possible scenarios a 'specific machine to produce a useful, concrete, and tangible result'. Presently the computer does not produce a tangible result the entire processing is done within a single computer and therefore no tangible result is created" (sic)." In the remarks section of the Response filed on September 26, 2006 and in the Preliminary Amendment filed on October 26, 2007, 2006, the Applicant respectfully noted that the Examiner fails to provide a "full development of the reasons [for such rejection] rather than a mere conclusion coupled with some stereotyped expression," as required by MPEP 706.03. Specifically, the Examiner failed to offer any explanation of what claims fail to produce "a useful, concrete, and tangible result," or why not, other than that the entire processing is done within a single computer. In response, the Examiner provided two stock paragraphs, explaining that "computer programs claimed as computer listing per se, i.e., descriptions or expressions of programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are 'not' acts being performed." This text goes on to explain that computer programs are patentable subject matter when claimed as a part of an article of manufacture in the form of a computer-readable medium ("a claimed computer-readable medium encoded with a computer program's functionality to be realized...is thus statutory"), as "part of an otherwise statutory manufacture or machine" or "when a computer program is used in a computerized process where the

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computer executes the instructions set forth in the computer program." As the Examiner's text states "[o]nly when the claimed invention taken as a whole is directed to a mere program listing...is it descriptive material per ser and hence nonstatuory." Applicant does not disagree, but finds the content of these paragraphs non-applicable to the pending claims, as explained in detail below.

The Examiner then proceeds to make a one sentence statement that the pending claims recite "instant messages, and a telephone number, but no statutory machine or manufacture," without offering any explanation as to why not.

Applicant respectfully notes that Claims 1-21 are method claims, claiming "acts being performed" and clearly constituting a process. It is well established law that a method is a form of a process, which is statutorily patentable subject matter. (see, e.g., *Expanded Metal Co. v. Bradford*, 214 U.S. 366 (1909)). By the Examiner's own admission, "a computer program... used in a computerized process where the computer executes the instructions set forth in the computer program" is patentable subject matter. Claims 1-21 clearly and unequivocally recite performing specific steps. Claims 1, for example, specifically recites performing the following steps:

> **receiving an electronic message** addressed to a telephone number;
> **determining an instant message identifier** associated with the telephone number;
> **determining in real time whether an instant message receiver is currently available to receive messages** addressed to the instant message identifier; and
> **performing a step** form a group of steps consisting of:
> > **forwarding the electronic message** as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; and
> > **sending the electronic message** to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier. (empahsis added)

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This not a recitation of "a mere program listing," but instead a claiming of a series of steps where "'the computer executes the instructions set forth in the computer program," and hence comprises a statutory process.

Claims 22- 41 are apparatus claims. These claims clearly do not merely recite "electronic messages and a telephone number" but instead a number of modules configured to execute the steps of the methods of claims 1-21. It is a well established matter of law that a programmable computer programmed to execute novel steps comprises a patentable machine. (see, e.g., *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999)). Claim 22, for example, recites the following modules:

a module for receiving an electronic message addressed to a telephone number;

a module for determining an instant message identifier associated with the telephone number;

a module for determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier;

a module for forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; and

a module for sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier. (emphasis added)

Finally, claims 42-61 recite "A program storage medium readable by a computer, tangibly embodying a program of instructions executable by the computer." Thus, these claims recite a computer-readable medium, which is patentable subject matter by the Examiner's own admission, as well as the established patent law. (see, e.g., *In Re*

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Beauregard, 53 F.3d 1583 (Fed. Cir. 1995)).

In summary, the Examiner gives two reasons given for the 35 U.S.C. § 101 rejection of all pending claims: 1) the pending claims recite "'instant messages, and a telephone number, but no statutory machine or manufacture," and 2) "the computer does not produce a tangible result the entire processing is done within a single computer and therefore no tangible result is created" (sic). As explained above, it is not correct that the pending claims recite "'instant messages, and a telephone number, but no statutory machine or manufacture." Instead, as explained, the pending claims recite statutory processes, machines and articles of manufacture.

Concerning the Examiner's original argument that the computer does not produce a tangible result the entire processing is done within a single computer and therefore no tangible result is created" (sic), as discussed in the last response, there is no prohibition in 35 U.S.C. § 101, or in the rules or case law thereon, barring claims that recite processing by a single computer. Therefore, the Examiner is not allowed to reject claims under 35 U.S.C. § 101 because all processing in a claim is performed by a single computer, but only because the pending claims lack patentable utility as defined by the statute, rules and case law.

As Applicant has already noted, for at least the following reasons, the invention as recited by the pending claims does produce a useful, concrete, and tangible result under all circumstances. Claim 1 recites "receiving an electronic message addressed to a telephone number...determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant message... to

the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number" based on whether or not an instant message receiver is currently available. This is a useful, concrete, and tangible result, produced under all circumstances. The method will either forward the electronic message to an instant message receiver or to a mobile device, depending upon whether an instant message receiver is available. Either way, a tangible useful result occurs: an electronic message is transmitted to a desired target. The method is concrete in that depending upon a specific determination (whether an instant message receiver is currently available), the method will execute one step or the other (send message to instant message receiver or send message to mobile device).

Claims 2-21 dependent from claim 1 and are thus useful for at least the same reasons as claim 1. Claims 22-41 are apparatus claims similar in scope to claims 1-21, and are thus useful for at least the same reasons as claims 1-21. Claims 42-61 are program storage medium claims similar in scope to claims 1-21, and are thus useful for at least the same reasons as claims 1-21.

Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 101 rejection, or provide a "full development of the reasons [for such rejection] rather than a mere conclusion coupled with some stereotyped expression," as required by MPEP 706.03. As Applicant as outlined in detail how the claims do recite useful, patentable statutory subject matter, Applicant respectfully requests that if the Examiner remains convinced that Applicant is incorrect, the Examiner address Applicant's arguments.

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The 35 U.S.C. § 102(e) Rejection

The Examiner rejected claims 1-61 under 35 U.S.C. 102(e) as being anticipated by Dehlin. Applicant respectfully traverses this rejection. Claim 1 recites "receiving an electronic message addressed to a telephone number, determining an instant message identifier associated with the telephone number, determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant message... to the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number" based on whether or not an instant message receiver is currently available. In other words, an electronic message is sent to a telephone number, and sent either to an instant message receiver or a mobile device, based on whether an instant message receiver is currently available to receive the instant message. More specifically, claim 1 recites receiving an electronic message that is addressed to a telephone number, locating an instant message identifier associated with that telephone number, and determining in real time to where to send the message depending upon whether an instant message receiver is currently available to receive instant messages sent to the instant message identifier associated with the telephone number. If so, the electronic message is sent to the instant message receiver. If not, the electronic message is sent to a mobile device at the telephone number. Thus, when a user is currently available to receive instant messages, incoming messages are sent to the user; when the user is unavailable, the messages are routed to the user's mobile device (e.g., cell phone).

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The above described limitations are neither disclosed nor suggested by Dehlin. Instead, Dehlin describes a system for extending instant messaging to mobile devices not connected to the Internet (col. 1, lines 50-54). In Dehlin, "a mobile [device] user registers an alias with the instant messaging service. Registering an alias associates the alias with a mobile device." (col. 6, lines 38-40). An alias comprises a screen name or handle, for use in instant messaging. A computer user operating a personal computer sends an instant message to an alias. (col. 4, lines 51-56). Next, "an incoming IM message addressed to the alias (i.e., recipient alias) associated with the mobile device is received [by an Instant Message Server]. The incoming IM message is generated from another individual on a first computing device. The other individual also has an alias stored with the instant messaging service." (col. 6, lines 49-52. see also, Figure 3, illustrating an IM Server receiving an instant message sent to an alias by a personal computer). As Dehlin explains, "Typically, IM messages are exchanged through persistent Internet connections between two individuals on their personal computers. However, with a mobile device, a persistent Internet connection is not typically connected." (col. 6, lines 54-58). To solve this problem, Dehlin converts the instant message into a Short Messaging Service (SMS) Message. (col. 6, lines 60-61). As Dehlin defines it, "Short Messaging Service (SMS) is a service that allows short text/data messages to be sent and received on Global System for Mobile Communications (GSM) cellular networks." (col. 6, lines 14-18). Although the mobile device is not connected to the Internet and thus cannot receive instant messages, the mobile device is connected to a cellular network, and hence can receive SMS

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messages. (col. 6, lines 61-64). The Instant Messaging Server then sends the SMS to the mobile device associated with the alias.

Unlike Applicant's pending claims, Dehlin involves receiving an instant message addressed to an instant messaging alias, converting the instant message into an SMS message, and sending the SMS message to a mobile device. The mobile device is not connected to the Internet (i.e., available to receive an instant message) so Dehlin sends the mobile device a corresponding SMS message instead.

Applicant's pending claims, (e.g., claim 1) on the other hand, recite receiving an electronic message that is addressed to a telephone number, locating an instant message identifier associated with that telephone number, and determining in real time to where to send the message depending upon whether an instant message receiver is currently available to receive instant messages sent to the instant message identifier associated with the telephone number. If so, the electronic message is sent to the instant message receiver. If not, the electronic message is sent to a mobile device at the telephone number.

The differences between Applicant's claims and Dehlin are many. First, Dehlin does not disclose or suggest "receiving an electronic message that is addressed *to a telephone number*." Instead, in Dehlin, the instant messages are addressed to an alias, which is not the telephone number of a mobile device, but instead an instant messaging screen name. Note that in Dehlin, both mobile devices and personal computers have instant messaging aliases. (see, e.g., col. 6, lines 49-54). For support of his position that Dehlin does disclose this limitation, the Examiner cites, without explanation, col. 6, lines 12-27. Applicant respectfully notes that col. 6, lines 12-27

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explain the SMS format used for mobile device communication. Nothing in col. 6, lines 12-27 states or suggests that the Instant Message Server receives SMS messages addressed to a mobile device. Instead, as explained above, in Dehlin the Instant Message Server receives instant messages addressed to an alias, looks up the association between the alias and the mobile device, and sends an SMS message to the mobile device.

Dehlin further fails to disclose or suggest "*determining an instant message identifier* associated with the telephone number." Instead, Dehlin determines a mobile user associated with an alias (i.e., the mobile user that registered the alias). This is not the same thing; in fact it is the opposite. The Examiner's citation to Dehlin for this limitation is col. 6, lines 35-47, which as explained above discuss an Instant Message Server receiving an instant message addressed to an alias and looking up the mobile device associated with that alias.

Additionally, Dehlin fails to disclose "determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier." The whole point of Dehlin is that messages are sent to mobile devices that are not connected to the Internet. When an incoming instant message addressed to an alias is received, the Instant Message Server simply forwards a corresponding SMS message to the mobile device, regardless of whether the mobile device is connected to the Internet. Thus in Dehlin, the message is *always sent to the mobile device.* In claim 1, by contrast, a determination is made as to whether the user is available. Based on the results of the determination, the message is sent either to instant message identifier or to the telephone number.

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For support of the disclosure of the determining step in Dehlin, the Examiner cites to col. 5, lines 13-21 and col. 7, lines 20-25. Col. 5, lines 13-21 discusses the MSN MESSENGER instant messenger service, which can be used to send instant messages between two aliases that are both connected to the Internet. Nothing in this citation discloses or suggests making a determination as to "whether an instant message receiver is currently available" and performing alternative steps based on the result. Col. 7, lines 20-25, on the other hand, discuss a chat session between a personal computer and a mobile device using the technique of Dehlin. Again, absolutely no mention is made of making a determination of whether a user is available, and sending the message to one place if so and another if not.

These distinctions are substantive. Dehlin enables transmitting messages between personal computers connected to the Internet and mobile devices that are not. Applicant's invention as recited by claim 1 concerns determining whether to send an individual message addressed to a specific target to an instant message receiver or a mobile device associated with a telephone number, based upon whether the user is currently available to receive instant messages. These are different problems, and as explained above they are solved in different ways, through the use of different mechanisms and methodologies.
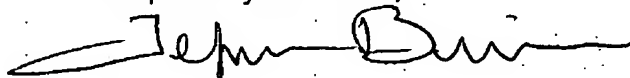
Claims 2-21 dependent from claim 1 and are thus novel for at least the same reasons as claim 1. Claims 22-41 are apparatus claims similar in scope to claims 1-21, and are thus novel for at least the same reasons as claims 1-21. Claims 42-61 are program storage medium claims similar in scope to claims 1-21, and are thus novel for at least the same reasons as claims 1-21. Although moot in light of the above, for the

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record Applicant respectfully traverses the Examiner's assertion that the additional recited limitations of the dependent claims are anticipated by Dehlin.

Applicant respectfully posits that all objections to and rejections of the pending claims have been overcome. Accordingly, Applicant respectfully requests allowance of all claims as amended. If the Examiner would like to discuss this matter, Applicant's attorney can be reached at 650-474-8400.

Respectfully submitted,

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